

Remarks

This Response is to an Office Action mailed September 17, 2003.

Applicant has amended claims 1-4 and 7, and has canceled claim 8, being drawn to a non-elected invention.

I. Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-7 are rejected under 35 U.S.C. Section 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter for which applicant regards as the invention. Office Action, page 3, paragraph 5. Applicants reiterate previous remarks and incorporate them herein fully by reference.

5B. Regarding the term "prophylaxis," Applicants respectfully submit that it is well known in the art that Parkinson's disease as well as other diseases can have variability over time in the severity of symptoms. In a state of remission, a particular functional symptom may not be present (e.g., ataxia), but the underlying condition (Parkinson's disease) is still present. Therefore, Applicants submit that an asymptomatic patient with Parkinson's disease is not disease-free. Under such conditions, an asymptomatic patient can be treated with GPE to prevent symptoms from reappearing or decreasing their severity if they do reappear.

However, to move the case forward, Applicants have amended claim 1 to delete the term "prophylaxis" and submit that it is not a narrowing amendment, as the Examiner believes that the term "prophylaxis" is encompassed within the term "treatment." Additionally, Applicants have amended claim 5 to more particularly point what the Applicants consider to be the invention.

5C. Regarding the meaning of "a functional symptom of Parkinson's disease," Applicants have amended claim 1 to explicitly state what was inherent in the claim before amendment. Thus, Applicants have specifically claimed the "functional symptoms" of Parkinson's disease disclosed in the specification.

5E. Applicants have removed the limitation "prodrug thereof" from the claims..

5F. Regarding claim 1, Applicants have amended the claims to recite the step of "administering."

II. Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1-3 and 5-7 stand rejected under 35 U.S.C. Section 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Office Action, page 7, paragraph 6.

Applicants have amended claim 1 to exclude the term "prodrug."

Claims 1-7 stand rejected under 35 U.S.C. Section 112, first paragraph for lack of enablement. Office Action, page 13, paragraph 7.

Applicants have amended the claims to delete the term "prodrug." and thus submit that the claims are fully enabled.

Rejections Under 35 U.S.C. §102

Claims 1-7 are rejected under 35 U.S.C. 102(a, b) as being anticipated by Gluckman, WO 93/02695 (the "'695" patent). Office Action, page 19, paragraph 8.

Applicants request the Examiner's assistance in identifying particular locations within the '695 patent that the Examiner believes supports the rejection of the instant claims. Applicants can identify no disclosure that anticipates "A method for treating a functional symptom of Parkinson's disease" as defined in the instant specification. In particular, Applicants can find no disclosure of "tremor at rest, muscular rigidity, a slowness of movement initiation and movement execution" or "a mask-like appearance to the face." Therefore, the '695 patent does not teach all limitations of the claims, and thus cannot anticipate the instant claims. Applicants therefore urge the Examiner to reconsider the rejections and find the claims allowable over the '695 patent.

Claims 1-7 are rejected under 35 U.S.C. 102(a, e) as being anticipated by Gluckman et al, U.S. Patent No. 6,187,906 (the "'906" patent). Office Action, page 20, paragraph 9.

Applicants have amended the claims to recite specific functional symptoms of Parkinson's disease and submit that Gluckman et al, cannot anticipate the claims as amended.

Rejections Under 35 U.S.C. §103

Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noble et al. U.S. Pat. No. 5,762,922 (the "922" patent). Office Action, page 21, paragraph 10.

Applicants have amended the claims to limit the treatment to "administration of an effective amount of GPE" and have limited the claims to particular, delineated functional symptoms of Parkinson's disease.

Double Patenting

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,187,906 (the "906" patent). Office Action, page 23, paragraph 11-12.

Applicants herewith provide a Terminal Disclaimer over U.S. 6,187,906, executed by the Applicant. Applicant submits that the obviousness type double patenting rejection is overcome by the Terminal Disclaimer.

Finally, Applicants have corrected the typographical error in Claim 2, line 2.

Conclusion

In light of the amendments to the claims and the remarks above, Applicants now believe that all currently pending claims are in condition for allowance. Therefore, Applicants respectfully request the Examiner to enter the amendment, find the claims allowable and issue a Notice of Allowance. If the undersigned attorney can be of assistance, please call the undersigned.

An Extension of Time for one month is due with this communication. Along with this Response, a Petition for Extension of Time and an executed Terminal Disclaimer are provided. The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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